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In the Supreme Court of the United States

OCTOBER TERM 1957
NO. 335

SOLAR CORPORATION, BY MERGER NOW GAMBLE-SKOGMO, INC.

Petitioner

VS.

BORG-WARNER CORPORATION

Respondent

PETITION FOR WRIT OF CERTIORARI

TO THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

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Respondent

PETITION FOR WRIT OF CERTIORARI

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner respectfully prays for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit.

The opinion of the Court of Appeals is reported in 113 USPQ 428, and a copy will be found in the Appendix hereto (p. 11).

The trial court filed no written opinion, merely adopting defendant's (respondent's) Findings of Fact and Conclusions of Law appearing in the Joint Appendix (Apx. 18-25).

A certified transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in accordance with the rules of this Court.

STATEMENT OF GROUNDS FOR JURISDICTION

The Judgment of the Court of Appeals to be reviewed was dated and entered May 24, 1957.

On Petition for Rehearing the Court of Appeals entered an Order correcting certain errors in its original opinion, but otherwise the Petition was denied July 9, 1957. A copy of such Order is included in the Appendix (p. 18).

By an Order, dated July 19, 1957, the Court of Appeals granted appellant's (petitioner's) Motion extending the time for filing this Petition for Writ of Certiorari to and including August 15, 1957.

This Court is believed to have jurisdiction to review the Judgment in question under 28 U. S. C. 1254(1), 62 Stat. 928.

Important questions of Patent Law, not heretofore settled by this Court, are raised. They deal particularly with the interpretation of Sections No. 103 and No. 282 of the Patent Act of 1952, about which there is a wide area of disagreement in other courts, and which have not been settled by this Court. This case would give this Court an opportunity to remove the existing uncertainty in such interpretation, a matter of great importance to the public, and to inventors and industry at large.

Review is further justified by the fact that both the trial court and the Court of Appeals misinterpreted and misapplied Sections No. 103 and No. 282 in a manner that subverts the Congressional intent of the Act, regardless of whether or not Section 103 modifies the criteria or standard of invention employed.

The possibility of conflict between circuits is remote.

Washing machines embodying the Castner invention are made, or made for, and sold, under license, by Gamble-Skogmo, Inc., Western Auto Supply Company, Firestone

Tire & Rubber Co., Hotpoint, Inc., Speed Queen Corporation, Easy Washing Machine Co., and others; all, except for respondent, comprising a very substantial section of the washing machine industry employing the vertical imperforate type of tub. Under these circumstances litigation elsewhere resulting in a conflict of decisions is improbable. This warrants review by this Court. *Makay Radio & Tele. Co. v. Radio Corp. of America,* 306 U. S. 86, 89; *Muncie Gear Works Inc. v. Outboard, Marine & Mfg. Co.,* 315 U. S. 759, 765-6; *Schriber-Schroth Co. v. Cleveland Trust Co.,* 305 U. S. 47, 50, 59 S. Ct. 8; and *Exhibit Supply Co. v. Ace Patents Corp.,* 315 U. S. 126, 126.

QUESTIONS PRESENTED

The questions presented are:

1. Does Section No. 103 of the Patent Act of 1952 liberalize the strict standard of invention which, for several years prior thereto, had been imposed by this Court as a prerequisite for sustaining the validity of a patent?

2. Can a patent claim be held invalid, under Sections No. 103 and No. 282 of the Patent Act of 1952, by merely assuming that separate features disclosed in two prior art patents could be hypothetically combined to meet the claim, when the structures disclosed in such patents were rejected by the Patent Office, as being non-anticipatory, and when the defendant, in a subsequent suit for infringement, offers no testimony or other evidence, even suggesting how such hypothetical combination of older features might be brought about?

STATUTORY PROVISIONS INVOLVED

Patent Act of July 19, 1952, c. 950, No. 1, 66 Stat. 798, 35 U. S. C. No. 103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Patent Act of July 19, 1952, 335 U. S. C. No. 282:

> "A patent shall be presumed valid. The burden of establishing invalidity shall rest on a party asserting it."

STATEMENT OF THE CASE

This is a patent infringement suit initially brought on two Castner patents and a Roth patent, all owned by petitioner, and all pertaining to clothes washing machines of the domestic type. Federal jurisdiction of the trial court was admitted to exist under the Patent Laws of the United States (28 U. S. C. 1338).

Certain claims of the three patents in suit were admittedly infringed if valid. The trial court (Judge Philip L. Sullivan) concluded that other claims were not infringed, and that all the claims in suit were invalid (Apx. 25). With respect to the Castner reissue patent the trial court also found that respondent had certain intervening rights because its first accused tubs were made and sold before the reissue patent was applied for.

The Court of Appeals affirmed the trial court on the issues of validity, and did "not deem it essential to consider (the) other questions involved."

The conclusions of the lower courts with respect to the Roth patent 2,633,727 (Apx. 458-462) are not challenged in this Petition, but those with reference to the Castner patents are.

The first of the Castner patents, namely, original patent 2,470,140 (Apx. 446-551) was issued May 17, 1949. The second Castner patent, namely, Re. 23,626 (Apx. 452-457) is a reissue of the aforesaid original patent 2,470,140, and was granted March 10, 1953, on which date also, the original patent was of necessity terminated. The reason for including the original Castner patent in this suit was that the period of alleged infringement extended back to March 9, 1951, which was prior to the surrender date.

Petitioner relied upon claims 1, 4 and 5 of the original Castner patent, and upon claims 1, 4, 5, 6, 7 and 8 of the Castner reissue patent Claims 1, 4, and 5 of the two Castner patents are respectively identical. Claims 6, 7 and 8 of the reissue patent are identical with claim 4, as it appears in both patents, except for added limitations which render such claims 6, 7 and 8 more restricted in scope than said claim 4. It is in connection with claims 6, 7 and 8 that respondent asserted the so-called intervening rights.

A general understanding of the structure and operation of the Castner invention is believed essential. As shown in the drawings (Apx. 446-447) of the original patent, or in the identical drawings (Apx. 453 and 452) of the reissue patent, the pertinent structure includes a generally cylindrical tub C composed of a downwardly tapered imperforate side wall 12 having a dished bottom portion 14 terminating in an annular sediment trap 18, arranged under the skirt 27 of the agitator D. The trap 18 is provided with

one or more tubes 32 which extend outwardly and then upwardly along the outer side of the tub to a point above the normal liquid level in the tub so that the fluid cannot escape during the washing action.

During the washing operation, the agitator is oscillated to impart a toroidal action to the water and clothes. As this occurs the removed dirt of a light nature rises as scum to the surface while the heavier sediment filters downwardly until it contacts the dished bottom portion 14 of the tub and by it is directed into the annular trap 28.

With the washing cycle completed the tub is spun to create centrifugal forces that will discharge the main body of water, with its accumulated scum, from the upper end of the tub proper, while the sedimentary material, collected in the annular trap 28, will be forcefully ejected through and from the tubes 32. In this way neither the sediment nor the scum can return into deleterious contact with the cleaned clothes during the extraction process, and this constitutes the primary and all important objective of the invention.

The phenomenal success of the structure, as thus described, is shown by the fact that petitioner and its licensees have sold over Two Hundred Million Dollars worth of machines embodying the Castner invention.

The respondent's structure (Apx. 442) is substantially identical with petitioner's, except only that instead of using a completely open trap the bottom wall of the tub has a flange extension over the trap and it contains perforations which permit the sediment to move into the trap while also serving as a screen to hold out buttons and other objects from the annular recess.

The Castner claims in suit were held invalid, by the lower courts, over the patents to Dunham, 2,274,402 (Apx. 471-473) and Dyer, 2,313,928 (Apx. 561-575).

The Dunham patent was of record in the reissue proceedings and had been rejected by examiner as not being of an anticipatory nature, because it does not disclose an annular sediment trap. The Dyer patent was not a reference in the Patent Office proceedings, but it is identical, so far as the tub structure is concerned, with another Dyer patent, 2,392,652 (Apx. 484-490), which was of record in the Castner file, and it was rejected by the examiner, as not being anticipatory because it does not have the upper tub discharge which keeps the scum from returning into contact with the cleaned clothes.

ARGUMENT

Conflicting theories and decisions as to the real meaning and effect of Section No. 103 of the 1952 Patent Act, has produced great uncertainty and confusion.

In the proceedings below respondent argued that "The Patent Act of 1952 did not lower the 'severe' standard of invention laid down in Great A. & P. Tea Co. v. Supermarket Equip. Corp. (1950), 340 U. S. 147," citing *Stanley Works v. Rockwell Mfg. Co.* (3 Cir. 1953), 203 F. 2d 846, 849, and *General Motors Corp. v. Estate Stove Co.* (6. Cir. 1953), 203 F. 2d 912, c. d. (1953) 346 U. S. 822.

The Court of Appeal's decision (herein) refers to the Act, and apparently accepted the argument, as it applied the same "severe" standard, citing only its own 1938 decisions in *Higby v. A. B. T. Mfg. Co.*, 93 F. 2d 73, and *Mouckmeier v. Erie Mfg. Co.*, 98 F. 2d 369.

Until 1955 no court held that Section 103 did not change the standard of invention, but on June 20, 1955, Judge Learned Hand, of the Second Circuit Court of Appeals, in *Lyon v. Bausch & Lomb Optical Co.*, 224 F. 2d 530, c. d. 76 S. Ct. 193, 350 U. S. 911, did so hold. He disagreed

with certain earlier decisions which held Section No. 103 to be a mere codification of existing law, and stated that the new provision "restores the original gloss, substantially in ipsissimis verbis" (p. 536) the test of invention which existed some twenty years before, as compared with the more recent decisions by this Court, which he describes as "indubitably stricter than that defined in No. 103 (p. 535). Judge Hand also notes that "Certainly a legislature—is free to reinstate the courts' initial interpretation, etc." (p. 537).

Since the *Lyon v. Bausch & Lomb* decision the confusion as to Section No. 103 has increased.

Some courts have held that it is a mere codification or restatement of existing law. *Blish, Mize, et al., v. Time Saver Tools,* 236 F. 2d 913 (C. A. 10th), *Mojonnier Bros. Co. v. Talon Machinery Co.,* 230 F. 2d 850 (C. A. 3rd).

Other courts, however, interpret Section 103 differently, and in line with the thinking of Judge Hand. Thus in *L. O. F. Glass Fibers v. Watson,* 228 F. 2d 40, the U. S. Court of Appeals Dist. of Columbia said that "It may be safely assumed that 1952 Act was intended to restore law to what it was when the Court announced the definition of invention" (Footnote 14). See also *Brown v. Brock,* 240 F. 2d 723 (C. A. 4th).

Commentaries further pointing up the seriousness of the problem are found in:

Congress Revitalizes the Patent System, 39 Am. Bar Ass'n Journal March 1953, pp. 209-212; Transitional Problems of the New Patent Act, 35 Journal of the Patent Office Society May 1953, pp. 325-342. Some Aspects of the Underlying Legislative Intent of the Patent Act of 1952, 23 George Washington Law Review June 1955, pp. 658-699.

Another aspect of Section No. 103 is that to invalidate a claim it requires that the "subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." Section No. 282 of the 1952 Act specifically provides that "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it." It is believed that this mandatory provision should require and receive more than lip service.

It is obviously and literally impossible to read Castner's claims 4, 5, 6, 7 and 8 (and we disagree with the lower court's ruling as to claim 1, but that is not here important), on either Dunham or Dyer. It is only by academically combining these references that the "obviousness" in Section No. 103 can be made out.

How did respondent discharge its "burden of establishing" (Sec. No. 103) that "obviousness" (Sec. No. 282)? It offered in evidence bare copies of the Dunham and Dyer patents, the disclosures of which had been before and rejected by the examiner when he allowed the claims. Not one of respondent's witnesses was even prepared to discuss these patents, and there is not one scrap of evidence even remotely suggesting how Dunham or Dyer could or should be combined to produce the Castner invention either at the time of trial (April 1956) or "at the time (1945) the invention was made" (Sec. No. 103).

Thus the lower courts, in this case, have completely ignored these pertinent provisions of the 1952 Act, and to prevent reoccurrence of such practice, this Court should exercise its discretionary power on this important question of law.

If the Petition is granted the questions to be determined are: (1) Are claims 1, 4 and 5 of the original Castner patent 2,470,140, and claims 1, 4, 5, 6, 7 and 8 of the

reissue Castner patent Re. 23,626 valid? (2) Are claims 4 and 5 of the original and claims 4, 5, 6, 7 and 8 of the reissue Castner patent infringed? When a patent claim is clear and unambiguous can descriptive matter from the specification, not included in such claim, be read into the claim either to make out invalidity or non-infringement? The issue of intervening rights will be resolved if claim 4 of the original Castner patent is held to be valid and, as with other collateral issues, need not be discussed unless and until this Petition is granted.

As for the issues pointed up by this Petition, the law is in a confused state, and it is of special importance at the present time that this Court interpose its discretionary power to remove the uncertainties that now exist with reference to the noted Sections of the Patent Act of 1952.

The writ should issue.

Respectfully submitted,

July 29, 1957

ANDREW E. CARLSEN
DOUGLAS L. CARLSEN
EDWARD C. GRELLE

APPENDIX A

In The
United States Court of Appeals
For the Seventh Circuit

No. 11927 September Term 1956; April Session 1957.

Solar Corporation, by Merger now Gamble-Skogmo, Inc.,
Plaintiff-Appellant,

v.

Borg-Warner Corporation,
Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division

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May 24, 1957

Before Finnegan, Lindley and Schnackenberg, *Circuit Judges*

Lindley, *Circuit Judge*. Plaintiff's suit for infringement of the patents, Castner 2,470,140, claims 1, 4 and 5, reissue thereof 23,626, claims 1, 4, 5, 6, 7 and 8, and Roth, 2,633,727 claims 1 and 3, having resulted in a determination that all claims in suit were invalid, but that, if valid, defendant had infringed claim 1 of both Castner patents and claims 1 and 3 of the Roth patent, but not claims 4 and 5 of the original Castner patent, or claims 4, 5, 6, 7 and 8 of the reissue patent. Upon appeal, plaintiff insists that the trial court erroneously held (1) the claims invalid; (2) that, in view of the prior art, Castner's and Roth's

claims represent no invention over the prior art; and (3) that defendant had not infringed claims 4 and 5 of the original Castner patent, and claims 4, 5, 6, 7 and 8 of Castner's reissue.

The patents have to do with an automatic washing machine in which an imperforate tub is mounted upon a vertical axis. In operation, clothes are inserted in the tub at the top, and are washed by means of a reciprocal agitator which in effect churns the contents. In operating machines of this type the water therein is extracted and drained by spinning the tub rapidly, thereby producing centrifugal force by which the water is driven over the top of the tub. Two kinds of refuse result from this operation. The finely divided lighter particles of dirt thrown out of the clothes float on the water and collect on its surface as scum and are carried off by the water in rinsing. Heavier matters, such as grit and sand, settle at the bottom of the tub. Thus, the lighter refuse matter rises to the surface as scum and is "spun" or flushed out with the water. The heavier sediment tends to sink to the bottom. So, early in the art, the builders of such machines supplied traps at the bottom of the tub to collect the heavier sediment, from which it could be flushed out through a discharge conduit, when the tub was spun.

All claims involved have to do with patentee's specifically provided form and location of sediment trap and discharge tube. Claim one in each of the Castner patents reads as follows: "In a washing machine having a tub adapted to receive liquid and material to be washed and to be spun to centrifugally extract the liquid from the material, the tub being provided with a recess in its bottom to accumulate and trap sedimentary material during the washing operation and said recess having at least one outlet in its outer wall to discharge such trapped material

centrifugally as the tub is spun, and the said recess being so shaped that such outlet will be spaced further from the axis of rotation than other parts of the wall whereby the trapped sedimentary material will work from opposite sides toward said outlet by centrifugal action."

The district court, after consideration of documentary evidence, physical exhibits, demonstrations of equipment in open court, and oral testimony of various witnesses, made findings of fact to the effect that Dunham, 2,274,402 of 1942, anticipated Castner's claim 1; that the teachings of Dunham, 2,274,402, King, 974,075, Wright, 1,850,821, Smith, 2,637,188, and Dyer, 2,313,928 were such that neither Castner nor Roth achieved patentable invention over them; that it was not invention "to provide a single annular trap in conjunction with the funnelled bottom of Castner after the Dyer patent had shown the funnelled bottom construction with the annular sediment trap"; that claims 1 and 3 of Roth are not inventive over Smith, No. 2,637,188, and the original Castner patent; that defendant has certain intervening rights; that plaintiff's commercial success was not sufficient to be persuasive of invention upon Castner's part; that claim 1 of the original patent and of the reissue patent is anticipated; that claims 4 and 5 of the original patent, and 4, 5, 6, 7 and 8 of the reissue patent are "invalid for failure to define any invention over the prior art, and that claims 1 and 3 of Roth are invalid for want of invention."

It is obvious that where, as here, the trial court has been called upon to pass upon the credibility of oral testimony and to observe and evaluate the results of manipulation of the devices in question before it, as well as documentary evidence, under Rule 52(a) of the Federal Rules of Procedure, we cannot disturb the findings unless they are clearly erroneous. This is not a case where the dis-

trict court had before it only documentary evidence, which a court of review is as adequately prepared to interpret as the trial court, but rather one where the questions of credibility and credence were peculiarly within the province of the district court. This we must keep in mind in considering the plaintiff's contentions upon review.

The closest prior art is Dunham, which the court found "shows an automatic washing machine having a tub which is tapered upwardly so that during centrifugal drying the main body of the water is discharged through a series of outlet holes high on the wall of the tub. Dunham shows a plurality of sediment traps arranged under the perforated bottom of the tub into which sediment in the wash water may settle, the traps being extended into vertical tubes through which, during centrifugal drying, heavy particles which have found their way into the sediment traps will be discharged along with the water therein. It is obvious from the construction shown in Dunham's Fig. 1 that any sedimentary material which finds its way into the sediment trap thereof will be centrifugally discharged through the attached tube during spinning. Testimony of plaintiff's witness Dugger to the contrary gave no reason for his conclusion, and the court accepted the testimony of defendant's witness Colburn that the trap will empty, a fact impliedly conceded by Castner in applying for a reissue patent because of his discovery of the Dunham patent."

In addition the court made a special finding that Dyer "discloses a domestic washing machine with vertical agitator having a dished or funnelled bottom portion terminating in an annular sediment trap. Heavy material which collects in this trap is centrifugally discharged through adjacent passages and out over the sidewall of the outer riser during spinning."

Plaintiff asserts that neither of these patents anticipates, or represents any more than past attempts and failures in the industry to solve the problem which only Castner suceeded in solving. Dunham seems not to have been considered in the patent office upon the application for the original patent, but was before that office on the application for reissue. Claim 1 in each patent is the same. It is concerned, says the plaintiff, with the feature of so forming the sediment receiving recess that the trapped material will be flushed around to the discharge outlet in the outer wall, accomplished by making the outer wall of the annular recess elliptical or cam-shaped, or, in other words, somewhat funnel-shaped, toward the outlet. By this construction, the patentee claimed that the trapped sedimentary material will work from opposite sides toward the outlet by centrifugal action. Plaintiff insists, moreover, that Dunham's disclosure does not structurally or functionally respond to the Castner claim; that Dunham's channel is relatively small and not annular in form, and therefore cannot receive sufficient water to create a flushing action of sufficient velocity to carry away sand or other heavy sediment; that sediment disposal was far from Dunham's mind, and that his intent was merely to form an overflow for liquid during the washing operation.

In reply, defendant insists that, under the oral testimony presented by it, there was no question but that the heavy dirt which fell into the recess in Dunham would be thrown out by centrifugal force. Testimony for the plaintiff was to the contrary. Dunham said in his specification: "Inasmuch as the sediment trap 28 is annular in form and extends entirely around the base plate, under and concentric with the agitator skirt, it will be seen that all areas of the dished bottom part 14 of the tub will drain freely and directly into the trap." And his claim 1, we think, reads literally upon Castner's claims.

The court saw demonstrated each of these machines as well as others. It had the benefit of the testimony, and concluded that Dunham completely anticipated claim 1. We have examined the evidence. We have not had before us the demonstrations made in the district court, but we are convinced that, under the evidence preserved, the court was justified in finding, upon contradictory evidence, that Dunham anticipated claim 1 of each of Castner's patents and that the prior art was of such character as to negative invention upon the part of Castner and Roth in any of the claims in suit.

We think the evidence adequately supports the finding that with this prior art before him, Castner's achievement did not rise to the dignity of patentable invention. As we said in *Higby v. A. B. T. Mfg. Co.*, 93 F. 2d 73, 74: "* * * A mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in same way by substantially the same means with better results, is not such achievement as will sustain a patent." See also our opinion in *Monckmeier v. Erie Mfg. Co.*, 98 F. 2d 369. The Patent Act of 1952, §105, provides that a patent may not be obtained "* * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains * * *." So here, we conclude that the court was justified in finding that the prior art of which Castner and Roth were bound to take notice taught them all that they, as skilled mechanics, needed to be taught in order to do what they accomplished.

It should be observed that Castner was not the first to devise an annular sediment trap. Dyer, in 2,313,928 had already done that.

The court found claims 1 and 3 of Roth, 2,633,727 not inventive over the original Castner patent. Roth asserted improvement in the curving of the discharge pipe used by both, so that the discharge end trails the lower end of the tub. Everything else in Roth was found in Castner. This curve, so far as facility and utility is concerned, is said to depend upon its sloped character, and plaintiff claims that the result is achieved because of the effects of inertia of the water passing through. Some of plaintiff's tubs included this sloped tube. Others did not, and defendant's structure apparently does not include it. We agree with the district court that Roth did nothing more than make an improvement that would occur to any worker skilled in the art. Furthermore, there was evidence to the effect that the so-called improvement was of little or no value and the court in effect so found.

In view of our conclusions, we think this opinion need not be extended by minute discussion of the remaining prior art references, none of which detracts in any way from what we have said. We do not deem it essential to consider other questions presented.

The judgment is affirmed.

A true Copy:

Teste:

Clerk of the United States Court of Appeals for the Seventh Circuit.

APPENDIX B

In The
United States Court of Appeals
For the Seventh Circuit

No. 11927 September Term 1956, April Session 1957

Solar Corporation, by Merger now Gamble-Skogmo, Inc.,
Plaintiff-Appellant,

v.

Borg-Warner Corporation,
Defendant-Appellee.

On Rehearing

July 9, 1957

Before Finnegan, Lindley and Schnackenberg, *Circuit Judges.*

Lindley, *Circuit Judge.* It is ordered that the last paragraph on page 4, and ending on the top of page 5 of the printed opinion, is stricken, and the following paragraph substituted:

"In reply, defendant insists that, under the oral testimony presented by it, there was no question but that the heavy dirt which fell into the recess in Dunham would be thrown out by centrifugal force. Testimony for the plaintiff was to the contrary. Castner said in his specification: 'Inasmuch as the sediment trap 28 is annular in form and extends

entirely around the base plate, under and concentric with the agitator skirt, it will be seen that all areas of the dished bottom part 14 of the tub will drain freely and directly into the trap.' His claim 1, we think, reads literally upon Dunham's disclosure."

This substitution having been made, the petition for rehearing is denied.

A true Copy:

Teste:

Clerk of the United States Court of Appeals for the Seventh Circuit.